

*Application No. 10/822581*  
*Page 5*

*Amendment*  
*Attorney Docket No. S63.2B-10865-US01*

**Remarks**

*Grounds for entry of Jan 31, 2006 Amendments:*

1. The Office Action dated **December 27, 2005** was prematurely indicated as a Final Office Action. A separate paper being filed herewith formally requests withdrawal of the Finality status of that Action. At least on that basis, the Advisory Action improperly refuses entry of the January 31, 2006 Amendment.

2. The Advisory Action recognizes that the January 31, 2006 Amendment overcomes §102 rejections on Wang '969 or Samuelson '683, but refused to enter the Amendment on the assertion that they did not overcome the §102 rejections over Boer '358 and the § 103 rejections. Respectfully, it is submitted that removal of some issues is a proper basis for entry of an Amendment, even if the Finality status was proper. The number of issues for appeal would have been reduced and this alone is proper grounds for entry of an amendment after Final.

3. The Examiner in the March 10, 2006 interview suggested that an entry of the amendment of Claim 1 might result in restriction since it did not include all of the species which had originally been listed in the Markush group of original claim 9. In particular, the Markush group inserted into claim 1 does not include the "polycarboxylic acids" species recited in original claim 9. This comment was taken as an assertion that a theory of a "constructive election" might be raised as a basis for refusing entry of the amendment of Claim 1. The applicant does not agree that an assertion of a constructive election would be a proper basis for objection in this case.

Original Claim 9 presented a Markush group of 5 members. The issue of restriction between those members was presented by that claim. In particular, MPEP 803.02, 4<sup>th</sup> paragraph, states:

A Markush-type claim may include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). In applications containing a Markush-type claim that encompasses at least two independent or distinct inventions, the examiner may require a provisional election of a single species *prior to examination on the merits*. An examiner should set forth a requirement for election of a single disclosed species in a Markush-type claim using form paragraph 8.01 when claims limited to species are present or using form paragraph 8.02 when no species claims are present. See MPEP § 808.01(a) and § 809.02(a). Following election, the Markush-type

*Application No. 10/822581*  
*Page 6*

*Amendment*  
*Attorney Docket No. S63.2B-10865-US01*

claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable over the prior art, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.  
(emphasis added)

Provisional election between the five members in the Markush group of claim 9 was not required before examination on the merits began. Therefore it is submitted that the Applicant cannot have constructively elected any individual member prior to the January 31, 2006 amendment of claim 1. Accordingly it would not be a proper objection to entry of the January 31 Amendment if the Examiner now concludes that restriction between those species is necessary.

*Response to the Feb. 7, 2006 Advisory Action:*

On the merits of the outstanding rejections, it is again submitted that Claim 1 as amended recites a group consisting of polyepoxides, polyoxazalines, polycarbodiimides, and polyisocyanates. The rejections applied to claim 1 are understood as pertaining only to use of certain polycarboxylic acid compounds in some tie layer formulations. Neither the December 27, 2005 Office Action nor the Feb, 15, 2006 Advisory Action offer any reason why use of these compounds can be considered to be anticipated by Boer '358 or obvious from the art cited in the §103 rejections. Therefore as to *all* the grounds of rejection, including specifically "the 102 rejections over Boer '358 and the 103 rejections," the Jan 31, 2006 amendment of Claim 1 is seen to overcome such rejections.

With respect to claims 12 and 41, now both written in independent form, Applicant once again points out that these claims recite the catalyst is a component of the tie layer, not merely that a catalyst is present in one of the recited layers.<sup>1</sup> Shimura mentions use of a catalyst at col. 5, lines 40-44, but does not disclose use of a catalyst in a tie layer. The only use of catalyst in the Shimura examples is in a water-swellable outer lubricious layer. It neither teaches nor suggests a laminate as recited in either of these claims. Therefore, as to *all* the grounds of rejection, including specifically "the §102 rejections over Boer '358 and the 103 rejections," the references relied upon do not meet the recitations of Claim 12 and 41 and so should be withdrawn.

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<sup>1</sup> This is not a new issue raised by the Jan 31, 2006 Amendment. Claims 12 and 41 from their first presentation have

*Application No. 10/822581*  
*Page 7*

*Amendment*  
*Attorney Docket No. S63.2B-10865-US01*

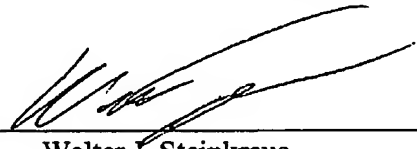
The remaining claims depend from one of claims 1, 12 or 41 and so are allowable at least for the reasons those claims are allowable.

*Conclusion*

Claims 1-8, 10-13 and 39-44, currently pending were properly amended in the Jan 31, 2006 Amendment for which entry is again requested. The Jan 31, 2006 amendments overcome all the outstanding grounds of rejection, not just those recognized in the Advisory Action. Therefore the application is now seen to be in condition for allowance. Early and favorable action thereon is respectfully requested.

Respectfully submitted,  
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always recited that the catalyst was a component of the tie layer.